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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/749,259

12/27/2000

David Freedman

FREEDMAN

4830

545

7590

05/06/2004

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EXAMINER

LIM, KRISNA

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 05/06/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

28

Office Action Summary

Application No.

09/749,259

Applicant(s)

FREEDMAN ET AL.

Examiner

Krisna Lim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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1. Claims 1-29 are presented for examination.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Knowles [U.S. Patent No. 6,622,917].
4. Knowles disclosed (e.g., see Figs. 1-9) the invention substantially as claimed. Taking claim 1 as an exemplary claim, the reference anticipated a method for supplying information to consumer on request (a method of surfing Web-sites (information resources) on the Internet), comprising the steps of:
 - a) composing an optically readable indicia (see a bar code reader of Fig. 1, an abstract, col. 2 (lines 36-51));
 - b) applying said optically readable indicia to an object (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51));

c) optically scanning said indicia to generating an electronic representation of said indicia (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51));

d) storing said electronic representation of said indicia, said storing being done by a device used to perform said optical scanning (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51), col. 16 (line 28) to col. 16 (line 67));

e) causing said computing device to communicate a signal to a central server, said signal including information to identifying said optical readable indicia (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51), col. 16 (line 28) to col. 16 (line 67));

g) programming said central server (Internet Server, Web-sites within the WWW) to associated said optical readable indicia with a plurality of addresses in response to selected criteria, whereby said optically readable indicia is associated with different addresses in response to differences in said selected criteria (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51), col. 16 (line 28) to col. 16 (line 67));

h) said central server (Internet Server, Web-sites within the WWW) being response to said signal i) to contact a sever at an address associated with said signal and said optically readable indicia, and ii) obtain information from said sever associated with said address and communicate said information received from said server associated with said address to said computing device for display or other user at said computing device (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51), col. 16 (line 28) to col. 16 (line 67)).

5. As to claim 2, Knowles further anticipated said central sever is responsive to said signal to contact said server at an address associated with said signal and optically readable indicia, and to the number of time of said contacting of said server (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51), col. 16 (line 28) to col. 16 (line 67)).

6. As to claim 3, Knowles further anticipated said criteria comprises different in location of said printed indicia (embed web site location 8 of Figs. 1-3, Web-site No.. 1

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to Website No. N, URL No. 1 to URL No. N of Fig. 5, Highlighted URL), whereby said optically readable indicia is associated in response to differences in the location of said printed indicia with different addresses (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51), col. 16 (line 28) to col. 16 (line 67)).

7. As to claim 4, Knowles further anticipated said criteria comprises different in location of consumer (embed web site location 8 of Figs. 1-3, Web-site No.. 1 to Website No. N, URL No. 1 to URL No. N of Fig. 5, Highlighted URL), whereby said optically readable indicia is associated in response to differences in the location of said printed indicia with different addresses (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51), col. 16 (line 28) to col. 16 (line 67)).

8. As to claim 5, Knowles further anticipated said composing an optically readable indicia comprising:

- a) creating a database record (e.g., B of Fig. 7A) on a central server by a database record owner;
- b) providing a database fields (e.g., see B of Fig. 7A) to associated said database record with a network address;
- c) populating certain of said database fields with data supplied by said database record owner (e.g., see Figs. 6B and 7A);
- d) populating certain of said database fields with data supplied by said central server (e.g., see Figs. 6B and 7A);
- e) printing said optically readable indicia (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51), col. 16 (line 28) to col. 16 (line 67)).

9. As to claim 28, such feature of the optically readable indicia (bar code reader) comprises invisible ink bar coding or digital watermarking was clearly taught y Knowles (e.g., see Figs. 2-3 and 6B, 8 and 9).

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the indicia are readable by magnetic or other non-optical device is inherent in a bar code reader.

10. As to claim 29, such feature of the indicia are readable by magnetic or other non-optical device is inherent in a bar code r

criteria comprises different in location of said printed indicia (embed web site location 8 of Figs. 1-3, Web-site No. 1 to Website No. N, URL No. 1 to URL No. N of Fig. 5), whereby said optically readable indicia is associated in response to differences in the location of said printed indicia with different addresses (see a bar code reader of Figs. 1-9, and abstract, col. 2 (lines 36-51), col. 16 (line 28) to col. 16 (line 67)).

11. Claims 9-27 are similar in scope as of claims 1-8 and 28-29, and therefore claims 9-27 are rejected for the same reasons set forth above for claims 1-8 and 28-29.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Krisna Lim whose telephone number is (703) 305-9672. The examiner can normally be reached on Monday-Friday from 7:30 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenton Burgess, can be reached at (703) 305-4772. The fax phone

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number for the organization where this application or proceeding is assigned is (703)
872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [glen.burgess@uspto.gov].

All Internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Office Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

kl

May 3, 2004



KRISNA LIM
PRIMARY EXAMINER